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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,650	01/03/2002	Haruko Toyoshima	0445-0316P	9924
2292	7590	08/31/2005		
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER KIDWELL, MICHELE M	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 08/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Tate

Office Action Summary	Application No. 10/019,650	Applicant(s) TOYOSHIMA ET AL.	
	Examiner Michele Kidwell	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 23, 2005 has been entered.

Claim Objections

Claim 1 is objected to because of the following informalities: the claim recites "the outer side" and "the inner side". These terms lack antecedent basis. Additionally, the word "has" in line 6 of the claim should be replaced with the word "have".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, the language is inconsistent. Line 15 of the claim recites "said elastic member in the said second set..." However, line 10 of the claim recites a second set of elastic members. Therefore, the scope of claim 1 is unclear since it is unclear which elastic member the applicant is referring to. Additionally, line 7 recites folding back a free side and line 18 includes a second recitation of a folded back portion. Are there two folded back portions? Appropriate correction and/or clarification are required.

With reference to claim 7, the applicant discloses an elastic member-carrying three-dimensional guard on opposite sides of the absorbent article. This requires a guard on each side of the article with an elastic member included therein. However, line 12 of the claim recites elastic members disposed and fixed to each of two separate portions. It is unclear how the one elastic member on each side of the guard can be attached to two separate sections. Is the one elastic member on the left side disposed and fixed to the skin contacting surface portion while the one elastic member on the right side is disposed and fixed to the widthwise central portion of the raised portion? Is the arrangement the other way around? Appropriate correction and/or clarification are required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 2, 6 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshioka (US 6,156,023)

With respect to claims 1 and 10, Yoshioka discloses an absorbent article which is provided with a liquid permeable surface sheet (2), a liquid impermeable leakage-prevention sheet (3) and a liquid-retaining absorbent formed substantially oblong (4), wherein the absorbent article is provided on longitudinal opposite sides thereof with a pair of right and left elastic member-carrying three-dimensional guards (figure 2), wherein the three-dimensional guards each as a skin contacting surface portion (figure 3) formed by folding back a side on a free side towards the outer side of the absorbent article; wherein a first set of elastic members are disposed and fixed to said skin-contacting surface portion and a second set of elastic members are disposed and fixed to an approximately width widthwise central portion of a raised portion, wherein the raised portion is located between the skin contacting surface portion and a base end of the three dimensional guard (figure 3); said raised portion is disposed toward the inner side of the diaper (figures 2 – 3); said elastic member in the second set in the raised portion is fixed between two sheet materials, wherein the two sheet materials form the three dimensional guard and a folded back portion is located between the skin-contacting surface portion and the raised portion as set forth in figure 3.

As to claim 2, Yoshioka discloses an absorbent article wherein a total width of the elastic member disposed on the skin contacting surface portion (24B, 24C, 24A) is larger than a total width of the elastic member disposed on the raised portion (30) as set forth in figure 3.

With reference to claim 6, Yoshioka discloses an absorbent article wherein the skin contacting surface is folded back along the elastic member at a part of the location of the elastic member nearest the raised portion as set forth in figure 3.

Claims 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Toyoda et al. (WO 97/12571)

With reference to claim 7, Toyoda et al. (hereinafter "Toyoda") discloses an absorbent article comprising a liquid permeable surface sheet (12), a liquid impermeable leakage-prevention sheet (14) and a liquid retaining absorbent (16) interposed between said liquid permeable surface sheet and said liquid impermeable leakage prevention sheet; wherein said absorbent article is substantially oblong and comprising a pair of right and left, elastic member-carrying three dimensional guards located on longitudinal opposite sides thereof (figures 1 and 4); wherein each of the three dimensional guards has a skin contacting surface portion formed by folding back a side on a free side towards the outer side of the absorbent article (figure 4); and said elastic members (22,26) are respectively disposed and fixed to (i) said skin-contacting surface portion (area generally designated by reference character "18") and (ii) an approximately widthwise central portion of a raised portion (area generally designated by reference character "22"), wherein the raised portion is located between the skin

contacting surface portion and a base end of the guard; (figure 4) wherein the elastic members in the skin-contacting surface portion of the three-dimensional guard are disposed at a smaller interval relative to the elastic members in the raised portion as shown in figure 4.

The examiner contends that elastic members are not required for each portion as previously explained.

Therefore, the elastic member in the skin-contacting surface portion of the three-dimensional guard would obviously be disposed at a smaller interval relative to the elastic members in the raised portion since there is no other elastic member in the skin-contacting surface portion.

In the alternative, the examiner may consider the hot melt (18) as an elastic member due to the inherent properties of hot melt adhesive and in this case, the elastic members in the skin-contacting surface portion of the three-dimensional guard are disposed at a smaller interval relative to the elastic members in the raised portion.

With reference to claim 9, Toyoda discloses an absorbent article further comprising a waist three dimensional guard having elastic members disposed on longitudinal opposite end portions as set forth on page 12, 1st paragraph and in figures 6 – 7 and 9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 – 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshioka (US 6,156,023).

The difference between Yoshioka and claim 3 is the provision that a ratio between $W1$ and $W2$ is $0.1 - 1.0$.

The examiner contends that this limitation is inherently met by the Yoshioka reference. Any portion of the skin contacting surface portion (large or small) may be considered $W1$ and any width of the raised portion may be considered $W2$. Therefore, the routine experimentation of these portions/widths may be measured to ultimately yield the claimed limitation.

With reference to claim 4, the examiner contends that Yoshioka inherently meets the claimed limitations because the applicant states that the portion having the larger elastic members will allow for the larger stress (page 7, lines 14 – 17 of the applicant's specification). Therefore, since Yoshioka provides larger or more elastic members on the skin-contacting portion (24B, 24C, 24A), then the skin-contacting portion will have a stress larger than the raised portion as claimed.

With respect to claim 5, see the rejection of claim 4. Any portion of the area designated 11 may be considered a leg portion having no leg gather. If the raised portion is bisected, the lower half (which is considered the area above reference numeral 16 in figure 3) will have a larger stress than the upper half portion (the area beneath reference numeral 16 in figure 3) for the same reasons listed above.

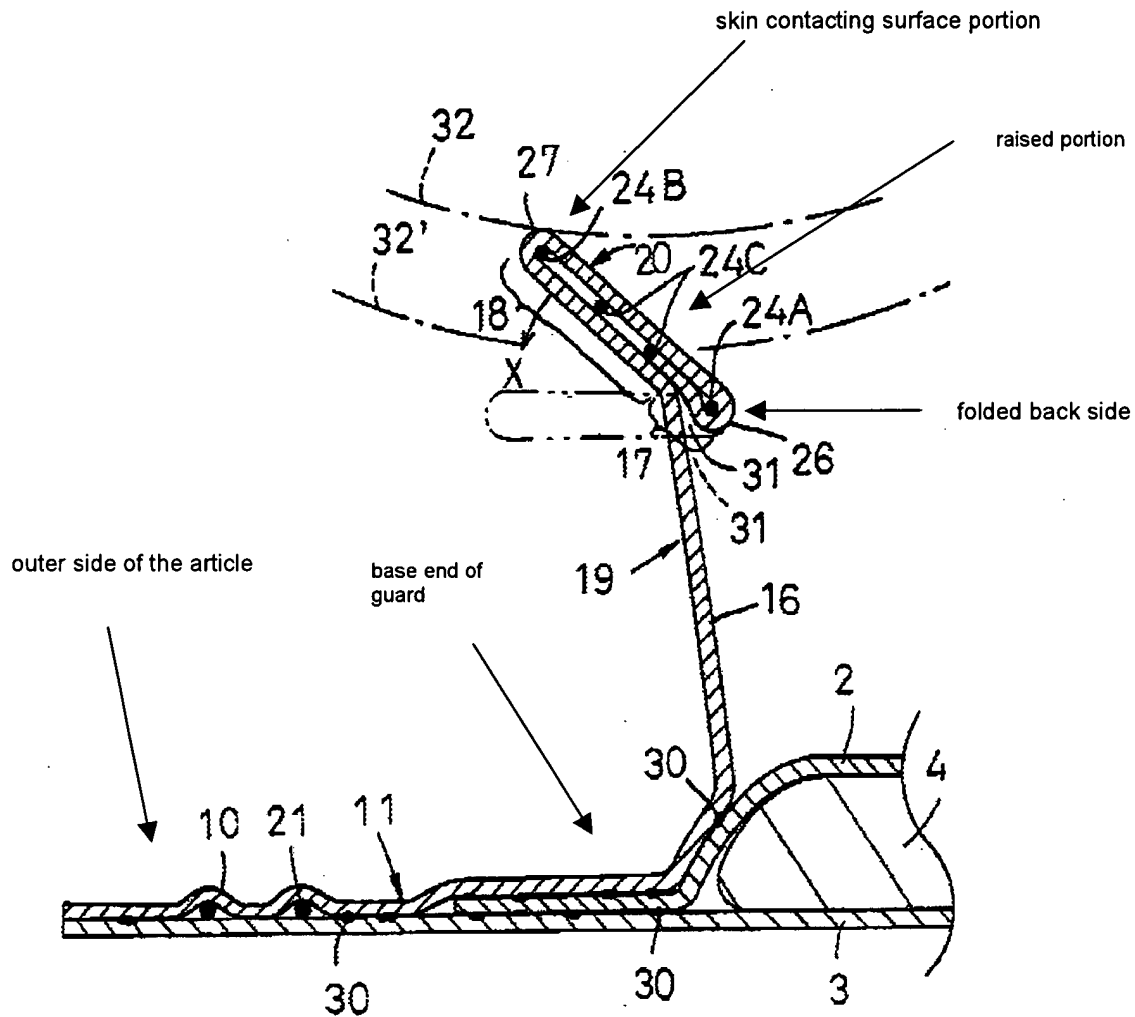
Response to Arguments

Applicant's arguments filed June 23, 2005 have been fully considered but they are not persuasive.

With respect to the applicant's arguments that a folded back portion is not located between the skin contacting surface and the raised portion, the examiner disagrees. A folded back portion as shown in figure 3 lies between the skin contacting portion (the top of the sheet designated generally by reference character "20") and the raised portion (the top of the sheet beginning with the second elastic labeled "24C" and continuing to the end of the portion designated generally by reference character "26").

Regarding the applicant's argument that a raised portion is not disposed toward the inside of the diaper, the examiner disagrees. A raised portion is disposed toward the inside of the diaper with respect to the edge of the diaper located outside of the area designated by reference character "10" as shown in figure 3.

Regarding the applicant's arguments with relation to the term "sets", the examiner contends that the claimed limitations with regard to the "sets" has been met and addressed in the rejection of claim 1 and as shown below in annotated figure 3. Yoshioka provides a "set" of elastic member on each of the claimed portions. Whether or not the set simultaneously contacts each portion is not a claimed limitation. The area above the raised portion arrow is considered the skin contacting surface portion having a set (24B and the first of 24C) of elastic members and the area below the raised portion arrow is considered the raised portion having a set (the second of 24C and 24A) of elastic members.



Lastly, the examiner maintains the rejection of claims 7 and 9 using the Toyoda reference as explained in the rejection of those claims above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 571-272-4935. The examiner can normally be reached on Monday - Friday, 5:30am - 2:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michele Kidwell
Primary Examiner
Art Unit 3761